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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
CHEVALIER, ALICIA ANN	
ART UNIT	PAPER NUMBER
1772	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/523,942	ANTONINI, FRED A.	
	Examiner	Art Unit	
	Alicia Chevalier	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-35 is/are pending in the application.

4a) Of the above claim(s) 26-35 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-25 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date 3/3/06,9/19/05.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-35 are pending in the application, claims 26-35 are withdrawn from consideration.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-25, drawn to a film, classified in class 428, subclass 156.

II. Claims 26-36, drawn to a method, classified in class 156, subclass 60.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a material different process such as injection molding.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and have acquired a separate status in the art because of their recognized divergent subject matter and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. James Walton on September 29, 2006 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-25. Affirmation of this election must be made by applicant in replying to this Office action.

Claims 26-35 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of copending Application No. 11/072382. Although the conflicting claims are not identical, they are not patentably distinct from each other because they claim the same film.

Application 11/072382 claims a film comprising a dimensionally stable, thin plastic film having a smooth surface finish, and a thin layer of silicone elastomer having a low durometer disposed on a first surface of the plastic film (*claim 1*).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-25 of copending Application No. 10/524367 in view of Siverson (U.S. Patent No. 6,840,836).

Application 10/524367 claims a film comprising a dimensionally stable, thin (*claim 2*) plastic film (*claim 24*) having a smooth surface finish, and a thin (*claim 2*) layer of silicone elastomer (*claims 17 and 19*) disposed on a first surface of the plastic film (*claims 1 and 20*).

Application 10/524367 fails to claim that the silicone has a low durometer.

Siverson discloses a flexible a flexible disk (*title*) made of silicone with a Shore A durometer hardness between 20 and 60, but most preferably about 40 (*col. 3, lines 55-58*).

Therefore, the exact durometer of the silicone elastomer layer is deemed to be a result effective variable with regard to the flexibility of the article. It would require routine experimentation to determine the optimum value of a result effective variable, such as durometer hardness, in the absence of a showing of criticality in the claimed durometer hardness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated to have a low durometer hardness such as less than 40 on a the Shore A hardness in order to insure flexibility.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "thin" in claim 1 is a relative term which renders the claim indefinite. The term "thin" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear what constitutes a "thin" film or layer, i.e. what dimensions are considered to be thin.

The term "low" in claim 1 is a relative term which renders the claim indefinite. The term "low" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear what constitutes a "low" durometer, i.e. what values are considered to be low.

The term "smooth" in claim 7 is a relative term which renders the claim indefinite. The term "smooth" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear what constitutes a "smooth" surface, i.e. is there surface 0.

The term "heavily" in claim 8 is a relative term which renders the claim indefinite. The term "heavily" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably

apprised of the scope of the invention. It is unclear what constitutes a "heavily" textured, i.e. what is the number on projections per area or what is the surface roughness.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobe et al. (U.S. Patent No. 6,372,323) in view of Siverson (U.S. Patent No. 6,840,836) and evidenced by Tokas et al. (U.S. Patent No. 6,960,272).

Regarding Applicant's claims 1 and 3, Kobe discloses a film comprising a plastic film (*additional backing layer, col. 5, lines 26-28 and 51-67*) and a silicone elastomer (*backing layer with stems, col. 5, lines 8-9 and col. 9, lines 48-49*) disposed on a first surface of the plastic film (*figure 1*). The plastic film is deemed to be thin (*col. 5, lines 35-36*) and dimensionally stable with a smooth surface, since figure 1 one shows the additional backing is flat, i.e. no texturing/projections, and is used to as a stabilizing layer (*col. 5, lines 26-27*). The silicone elastomer film is deemed to be thin (*col. 5, lines 35-36*). Kobe further discloses that the slip control article is flexible (*col. 1, lines 45-47*).

Kobe fails to discloses that the silicone elastomer has a low durometer, more specifically less than 40 on the Shore A scale.

Siverson discloses a flexible a flexible disk (*title*) made of silicone with a Shore A durometer hardness between 20 and 60, but most preferably about 40 (*col. 3, lines 55-58*).

Therefore, the exact durometer of the silicone elastomer layer is deemed to be a result effective variable with regard to the flexibility of the article. It would require routine experimentation to determine the optimum value of a result effective variable, such as durometer hardness, in the absence of a showing of criticality in the claimed durometer hardness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated by the fact that Kobe desires a flexible article to have a low durometer hardness such as less than 40 on a the Shore A hardness in order to insure flexibility.

Regarding Applicant's claim 2, Kobe discloses that the plastic film can be made of thermoplastic elastomers, such as polyolefin (*col. 5, lines 60-61*). Tokas shows that thermoplastic elastomers with polyolefinic material has a low surface energy, such as 28-30 dynes/cm (*col. 2, line 12-22*).

The limitation "co-extruded" is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113.

Regarding Applicant's claim 4, Kobe discloses that the film further comprises an adhesive disposed on a second surface of the plastic film (*col. 5, line 29 and figure 1*).

Regarding Applicant's claim 5, Kobe discloses that the film further comprises a releasable liner for covering the adhesive prior to use (*col. 5, line 29 and figure 1*).

Regarding Applicant's claims 6-10, the limitation "polished" is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. However, the method limitation "polished" does impart structure to the film, which is a flat or non-raised surface. Therefore, Kobe meets the limitation that the silicone elastomer has a polished surface finish, since figures 1 and 8 clearly show non-raised or flat portion on the article. Kobe also meets the limitation the polished surface finish is smooth since figure 1 clearly shows smooth, i.e. flat, portions between the stems. The surface is deemed to be heavily textured *(figure 8)*. As seen by figures 8 and 1 the silicone elastomer has textured and polished surface finish.

The limitation "polished surface finish is formed by a casting means having a polished surface finish" is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. Furthermore, there does not appear to be a difference between the prior art structure and the structure resulting from the claimed method because Kobe discloses a surface that is textured and flat.

Regarding Applicant's claim 11, Kobe discloses that the textured is in an array of upraised dimples (*figures 1 and 8*).

Regarding Applicant's claim 12, the silicone elastomer is deemed to has a matte finish since is contains projections (*figures 1 and 8*).

Regarding Applicant's claim 13, the limitation "wherein the plastic film is heat treated prior to application of the silicone elastomer" is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113.

Regarding Applicant's claim 14, Kobe discloses that the plastic film has a thickness of about 0.002 inches or less (*col. 5, lines 35-36*).

Regarding Applicant's claims 15-18, Kobe discloses that the plastic film or silicone elastomer can be tinted with pigments or dyes (*col. 5, lines 62-67*). Therefore, either the plastic film or silicone elastomer is deemed to comprises a graphical indicia, since either one may can pigments or dyes.

Regarding Applicant's claims 19-24, the limitations "for application on the fingertips of users," "for application on handheld devices," "for placement onto a material handling device," "for use on equipment used in games" and "configured to be sewn into fabric" are deemed to be statements with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a ***structural difference*** between the claimed invention and the prior art in order to patentably distinguish the

claimed invention from the prior art. MPEP § 2111.02. Furthermore, it is noted that Kobe's article is useful in golf clubs, baseball bats, household articles, non-slip walking surfaces etc. (*col. 1, lines 60-64*). The intended uses of Kobe's article include Applicant's intended uses for their film.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AC

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1/29/07

ALICIA CHEVALIER
PRIMARY EXAMINER